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10/017,394

12/18/2001

Kazuhiro Hayashi

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10/26/2009

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EXAMINER

SWEARINGEN, JEFFREY R

ART UNIT

PAPER NUMBER

2445

MAIL DATE

DELIVERY MODE

10/26/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/017,394

Applicant(s)

HAYASHI ET AL.

Examiner

Jeffrey R. Swearingen

Art Unit

2445

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 29-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 9/15/2009 have been fully considered but they are not persuasive.
2. Applicant argued Robinson in view of Morohashi failed to teach using a portable terminal in order to store a number of plays of pieces of music. Robinson teaches using a MP3 player to collect data on a user side. Robinson, column 10, lines 20-24. Robinson generated the information in the user's players. Robinson, column 10, lines 35-37. Morohashi was brought in to allow the elements of Robinson to occur using a portable terminal. The combination of Robinson and Morohashi taught using a portable terminal in order to store a number of plays of pieces of music.
3. Applicant argued Robinson in view of Morohashi failed to teach sending a number of plays of pieces of music to a server from a portable terminal to update such data on a server. Robinson taught transferring data from a user to a cluster in column 11, lines 35-46. Morohashi was brought in to allow the elements of Robinson to occur using a portable terminal. The combination of Robinson and Morohashi taught sending a number of plays of pieces of music to a server from a portable terminal to update such data on a server.
4. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

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USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson (US 7,072,846) in view of Morohashi (US 7,130,251).

7. In regard to claim 29, Robinson disclosed *a system for storing and playing music, comprising:*

*a server apparatus comprising*

*a storage section which stores data of pieces of music that a user possesses, and is adapted to store a number of plays of each of said pieces of music, column 10, lines 20-24*

*a reproducing section which plays back said data of pieces of music, music players on their machines, column 10, lines 23-24*

*an updating section that updates a number of plays of each piece of music that is played back, each time said playing back is completed at the portable terminal, and that stores the updated number of plays of each of said pieces of music in the terminal-side storage section; Robinson, column 11, lines 19-25*

*wherein, if the portable terminal is connected to the server apparatus through the interface, the updated number of plays of each of said pieces of music stored in the terminal-side storage section are sent to the server apparatus, and the server apparatus updates the number of plays of each of said pieces of music stored in the terminal-side storage section.* Robinson, column 11, lines 35-46.

Robinson disclosed the use of MP3, CD and other types of music players on a terminal device. Robinson never explicitly states the music players are portable, or that they can transfer data to and from a server.

Morohashi disclosed a system where a portable music player and a music server were interconnected for transmitting data. Morohashi, Figure 1. Morohashi disclosed data could be exchanged between the portable music player and the music server. Morohashi, column 6, lines 34-53.

Robinson updated the play count to reflect a user's "taste" in listening music. Robinson supported MP3 and CD players. Morohashi exchanged information with portable music players which utilized the MP3 format. (Morohashi, column 5, line 25). Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate data information collected from a portable music player in Morohashi with the play count feature of Robinson in order to track how often a user listened to a piece of music accurately, including both at a user terminal and a portable device.

8. Claim 30 is a method claim with substantially the same limitations as the system of claim 29.

9. Claim 31 is a portable terminal claim with substantially the same limitations as the system of claim 29.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Gebis US 6,993,290

12. Tagawa et al. US 7,096,504

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571)272-3921. The examiner can normally be reached on M-F 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on 571-272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jeffrey R. Swearingen  
Examiner  
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/J. R. S./  
Examiner, Art Unit 2445

/VIVEK SRIVASTAVA/

Supervisory Patent Examiner, Art Unit 2445